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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,584	02/28/2002	Robert J. Ward	INVSC.4	9027
7590	12/22/2003		EXAMINER	
Robert J. Ward 3313 Hidalgo Street Irving, TX 75062			MAI, TRI M	
			ART UNIT	PAPER NUMBER
			3727	
			DATE MAILED: 12/22/2003	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/086,584	WARD ET AL.
	Examiner Tri M. Mai	Art Unit 3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 44-57 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 44-57 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>15</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 44-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not teach the positioning of generally downwardly, and the outer cushioned layer operable to be squeezed and operable to return to the original shape. Furthermore, the original specification does not specify that leather (cl. 51), closed-cell foam (cl. 47), nylon (claim 50) being waterproof. Furthermore, the original specification does not specify water being used to impart a tacky grip. This is a new matter rejection.

2. Claims 49, 50, 51, and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It seems that at least nylon, and leather would not operable to return to its original shape after being squeezed as claimed.

“AMAFLEX” and “RUBATEX” are trade names and cannot be used in the claims.

In claim 49, it is confusing with respect to the outer being water-proof so that water may not pass through while having openings. It seems that having openings would contradict the limitations with respect to the may not passing through.

***Claim Rejections - 35 USC § 102***

3. Claims 44, 47, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Price (3965955). Price teaches an apparatus having an outer cushion material 14 (foamed plastic), an absorbent member (col. 2, line 23), and a coupling as shown in Fig. 2.

With respect to the outer cushioned layer operable to be squeeze and operable to return to the original shape, it is submitted that the cover in Price has the same functionalities as set forth in the claims since the cushioned layer is made from the same material as set forth. Furthermore, it is noted that the claims must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1985). See MPEP 2114. There is no structural difference between the Price and one set forth in the claim.

***Claim Rejections - 35 USC § 103***

4. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price. Price teaches an outer layer 14. It would have been obvious to one of ordinary skill in the art to provide outer layer 14 being a cloth material to provide an alternative material for the outer layer.

5. Claims 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Kinsey (6463971). Kinsey teaches that it is known in the art to provide a logo and/or brand name on a cover (col. 3, ln. 30). It would have been obvious to one of ordinary skill in the art to provide a logo and/or brand name on the cover in Eckstein as taught by Kinsey to sell the cover easily.

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6. Claims 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Thompson (4378832). Thompson teaches that it is known in the art to provide vents 24-29. It would have been obvious to one of ordinary skill in the art to provide vents in Proutt to provide ventilation.

7. Claims 44, 45, 47, 50, 51, 53, 54, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein (5203390) in view of Bucher (5118107). Eckstein teaches an outer cushion material (nylon), and an inner absorbent material (terry cloth fabric). With respect to the outer cushioned layer operable to be squeeze and operable to return to the original shape, it is submitted that the cover in Price has the same functionalities as set forth in the claims since the cushioned layer is made from the same material, i.e., nylon (col. 3, line 6) versus claim 50. Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1985). See MPEP 2114. There is no structural difference between the Price and one set forth in the claim.

Eckstein meets all claimed limitations except for the coupling. It would have been obvious to one of ordinary skill in the art to provide the coupling 37 in Eckstein as taught by Bucher to store the club and/or the cover easily.

Regarding claims 47, 51, it would have been obvious to one of ordinary skill in the art to provide the outer cushioned layer from closed-cell foam to leather to provide alternative material.

The modified cover of Eckstein would meet the steps as set forth in the method claim 57.

8. Claims 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Eckstein rejection as set forth above, and further in view of Jones (2987486). Jones teaches that

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it is known in the art to provide vents on a handle sleeve. It would have been obvious to one of ordinary skill in the art to provide vents in Eckstein as taught by Jones to provide proper ventilation.

Jones teaches that it is known in the art to provide rubber and other plastic. It would have been obvious to one of ordinary skill in the art to provide rubber and equivalent materials in Eckstein as taught by Jones to provide alternative material for the cover.

9. Claims 55, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Eckstein in view of Sullivan, Jr. (3147012). Eckstein meets all claimed limitations except for the compound to impart a tacky grip. Sullivan teaches that it is known in the art to wet the handle (col. 2, line 62). It would have been obvious to one of ordinary skill in the art to wet the handle in Eckstein as taught by Sullivan, Jr. to hold the grip securely.

Regarding claim 56, it would have been obvious to one of ordinary skill in the art to use water due to its availability.

#### *Response to Arguments*

Applicant's arguments filed 10/6/03 have been fully considered but they are not persuasive. New claims 44-57 have been entered in the case. However, these claims impart new matter into the case and do not read over the prior art of record as set forth above. With respect to the limitation that outer cushioned layer operable to be squeezed and operable to return to the original shape, It is submitted that the cover in Price has the same functionalities as set forth in the claims since the cushioned layer is made from the same material as set forth. Furthermore, it is noted that the claims must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover

what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1985). See MPEP 2114. There is no structural difference between the Price and one set forth in the claim.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai *T Mai*  
Primary Examiner  
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